

Attorney Docket No: 20341/67618
PATENT



2004
DEC 22 2004

BARNES & THORNBURG CUSTOMER NO:
23646
U.S. PATENT AND TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: James M. KAIN
Serial No.: 09/871,199 Art Unit: 3636
Filed: May 31, 2001 Examiner: Joseph F. Edell
For: JUVENILE SEAT ARMREST

REPLY BRIEF

Mail Stop Non-Fee Amendment
Commissioner for Patent
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In Response to the new issued raised in the Examiner's Answer of November 17, 2004,
Applicant's offer the following:

1. Grouping of claims – the Examiner's contention that 37 C.F.R. 1.192(c)(7) was not complied with is not correct. In the revised Appeal Brief filed August 24, 2004, the grouping of claims at paragraph No. 7 recites that claim 2 should be grouped separately from the rejection of claims 3, 9, 11 and 27-29 since ... and claims 13-14, 17 and 26 should be grouped differently from claims 15-16 and 18-24 since ... Further, in the last paragraph (pg. 5 lines 13-16) of the Argument Section, paragraph 9, an argument of the patentability for the above "since ..." clauses was presented. Thus, 37 C.F.R. 1.192(c)(7) was complied with.

SUPPLEMENTAL ARGUMENT

In countering Applicant's contention that there is no advantage to extending the U-shaped portions of the armrest of Lemmeyer upwardly and downwardly to allow the top bolt to be above the top of the armrest and the lower bolt belt below the armrest, the Examiner references col. 2 lines 6-10 of Kaufman for motivation. This "cheap" "simple" and "strong" arm recitation references a NON-CANTILEVERED arm with feet (b) at right angles to the arm rail (A) and with

balusters (B) with inturned perforated feet (c) along with the upper and lower attached lugs (a). Kaufman provides no teaching to modify a cantilevered arm with upper and lower fastening lugs. It is the balusters with inturned feet (c) and the attachment of the front of the arm with the right angle feet (b) along with the upper and lower attachment lugs (a) that provide the benefit for a NON-CANTILEVERED ARM. Nothing is presented by the Examiner as to why one concept of the 3-pronged Kaufman approach for “cheap” “simple” “strong” connection would be of use for a cantilevered arm. Rather, one skilled in the art desiring Kaufman’s “cheap,” “simple” “strong” attachment would replace the cantilevered arm of Lemmeyer with the non-cantilevered arm of Kaufman.

Still further, use of an attachment having an attachment both above and below the cantilevered arm of Lemmeyer would destroy the shelves 112 and 114 contact with surfaces 104, 106 of the U-shaped end of Lemmeyer’s arm 104, which contact provides the desired rigidity for his cantilevered arms. It is improper under 35 U.S.C. 103 to destroy the functioning of a primary reference to adopt a different construction without a teaching therefore. As such, this Examiner proposal constitutes an improper “hindsight” construction relying solely on Applicant’s teaching which is an improper basis for rejection.

As concerns the Examiner’s contention, that “the recitation of the relative bolt lengths is a matter of design choice that has no patentable significance,” is but a conclusion rather than a reason and thus is not a proper basis for rejection under U.S. Patent Law as clearly pointed out in the attached Ex Parte of William R. Garrett decision of this Honorable board.

Further, the Examiner is wrong as to U.S. Patent Law and the disclosure of the application, when he states that applicant has not disclosed having the specific bolt length and tongue thickness solves any stated problem, or is for any particular purpose. It appears that the armrest would perform equally well with any bolt length used in the old art. Under U.S. Patent Law, an Applicant does not need to recite a problem or particular purpose to have claim limitations accorded patentable limitations. The question of patentability is one of novelty under 35 U.S.C. 102 or obviousness under 35 U.S.C. 103. Every and any claim limitation supports patentability unless

shown to be not novel or shown to be obvious. The Examiner's contentions are concerning operating are just wrong. The specification does explain the utility of the shape and size of the connectors which is to conform to the backrest structure of the seat. See, for example, page 5 lines 16 plus of this application.

The Examiner's comments about Applicant's ignoring of the pivotal figures 5-7 of Lemmeyer et al. as concerns the rejections of claims 13-24 and 26, is not correct. The rejection references load support panel 49 of Walker, which is an extension of the seat attachment hooks 51, 53. The reference to Lemmeyer has a similar bottom shelf 114, 142 (fig. 6A). However, the independent claims recite:

Claim 13 "the cantilevered armrest further INCLUDES a load support panel arranged to lie in a FIXED position relative to the arm and the support means and to ENGAGE a ridge of the seat back to block pivotal movement ..."

Claim 15 "an arm having ... a load support panel arranged to abut the seat back ..."

Claim 21 "the cantilevered armrest further INCLUDES a load support panel to lie in a FIXED position relative to the arm and the support mount and to abut the ..."

In Walker the panel 49 is not part of the arm 42 (which incidentally is not a cantilevered arm) and is not in a FIXED position with respect to the arm and the support mount. Note arm 42 of Walker rotates.

It is these distinctions that render Walker's teaching (as applied) inappropriate, not that Lemmeyer has a rotating arm species. The load support panel 67 (see Fig. 3) of the instant application is fixed to the arm and immovable with respect thereto, a feature total absent in Walker. The Examiner has proffered no reason other than hindsight as to how the Lemmeyer ARM could (or should) be modified by Walker's teaching to provide for the claimed limitations. Thus, this rejection is but an impermissible hindsight rejection.

DEC 22 2004


SUMMARY

For the above additional reasoning, the Examiner's rejections should be reversed and such is requested.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and shortages in other fees, be charged, or any overpayment in fees be credited, to the Account of Barnes & Thornburg, Deposit Account No. 02-1010 (5723/70110).

Respectfully submitted,

Barnes & Thornburg

A handwritten signature in black ink, appearing to read 'M. Newman', followed by a horizontal line.

Mark M. Newman
Reg. No. 31,472
(202) 289-1313